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EXAMINER

GAUTHIER, GERALD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2645

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,557

Applicant(s)

PARSA, FERAL

Examiner

Gerald Gauthier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 4, 6, 13, 15 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirville et al. (US 5,745,553) in view of Herrero Garcia et al. (US 5,187,735).

Regarding **claims 1 and 13**, Herrero discloses a method for using a voice-messaging system to place long distance telephone calls (column 1, lines 6-14), (which

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reads on claimed "an integrated voice-mail based voice and information processing system"), comprising:

a voice-messaging system (300 on FIG. 1) receiving a toll-free call (column 18, line 24 "dials a telephone number") placed by a user (column 18, lines 24-37) [The caller dials a telephone number corresponding to multiple services of the VMS 300];

verifying that the user is a valid user of the voice-messaging system (column 13, lines 55-66) [The VCS 400 prompts the caller for information to verify that the caller has access to the system and requests the caller to dial in a confidential password];

receiving from the user a request (column 18, line 32 "DTMF-encoded selection") to place a long-distance telephone call (column 18, lines 24-37) [The VMS 300 provides a caller prompts with a number of options such as making a long distance call upon request dials the long distance number];

receiving from the user a telephone number (column 18, line 66 "the area code and the telephone number") of a third-party telephone line to be called (column 18, lines 38-68) [The VCS 400 invites the caller to dial the area code and the phone number to be called]; and

placing a telephone call (column 19, line 1 "dial the appropriate long distance telephone number") to the third-party telephone line associated with the third-party telephone number entered by the user (column 19, lines 1-4) [The VCS 400 routes the incoming call to the appropriate long distance destination].

Herrero discloses charging the user's credit card account but fails to disclose charging a pre-established user account of the user a pre-determined long-distance rate in relation to the telephone call.

However, McLeod teaches charging a pre-established user account (column 4, line 47 "the subscriber listing") of the user a pre-determined long-distance rate (column 4, line 48 "charges incurred") in relation to the telephone call (column 4, lines 30-50).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Herrero using the billing system as taught by McLeod.

This modification of the invention of Herrero enables the system to use the subscriber listing to charge the call so that the caller would have a single bill for the enhanced services.

Regarding **claims 4 and 15**, Herrero discloses, receiving and verifying a user-identification code and a password code (column 13, lines 55-66).

Regarding **claims 6 and 17**, Herrero discloses, wherein the user-identification code is associated with a billing account, and wherein the charges for the long-distance call are charged to the billing account (column 19, lines 5-19).

4. **Claims 2, 7-9, 11-12, 14, 18-20 and 22-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirville, in view of Herrero Garcia and in further view of Stabler (US 5,937,047).

Regarding **claims 2 and 14**, Herrero as applied to **claims 1 and 13** above differs from **claims 2 and 14** in that it fails to disclose connecting the telephone call to the third-party telephone line if the third-party telephone line is available.

However, Stabler teaches connecting the telephone call to the third-party telephone line if the third-party telephone line is available (column 6, lines 40-50).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use connecting the telephone call of Stabler in the messaging system of Herrero.

The modification of the invention would offer the capability of connecting the telephone call such as the system would offer an integrated voice-mail for economically providing advanced telephone call handling.

Regarding **claims 7 and 18**, Stabler teaches the voice-messaging system allows the user to choose between accessing voice messages or placing a telephone call (column 4, lines 52-65).

Regarding **claims 8 and 19**, Stabler teaches the voice-messaging system directs the user back to a voice-messaging-system menu if a third-party-call connection is not established (column 4, lines 52-65).

Regarding **claims 9 and 20**, Stabler teaches the voice-messaging system directs the user back to a voice-messaging-system menu when the user enters a pre-defined

signal at any step during the process of placing a call to a third party (column 4, lines 52-65).

Allowable Subject Matter

5. **Claims 10-12 and 21-23** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter.

The prior art at this time fails to disclose to establish a three-way call between the user, the voice-messaging system and the third party line.

Regarding **claim 24**, the prior art fails to disclose establishing a user account for a user, wherein the user account has associated with it pre-determined rates for placing telephone calls using the voice messaging system.

Response to Arguments

7. Applicant's arguments with respect to **claims 1-2, 4, 6, 13-15, 17-20 and 24** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER
g.g.

Allan Hoosain
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PRIMARY EXAMINER for
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May 31, 2004